

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

092/01664

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

Application Number

09/001,385

Filed

July 28, 2000

on _____

First Named Inventor

Aviv REFUAH et al.

Signature _____

Art Unit

2151

Examiner

DINH, Khanh Q.

Typed or printed
name _____

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 44,320

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Yaakov Schatz

Typed or printed name

1 (877) 428 5468

Telephone number

April 30, 2008

Date

NOTE: Signatures of all the inventor or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.



Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: A. RIFUAH, et al.
Serial Number: 09/601,385
Filed: July 28, 2000
For: PERSONALIZED INTERNET INTERACTION BY ADAPTING A PAGE
FORMAT TO A USER RECORD
Art Unit: 2151
Examiner: Dinh Khanh Q

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST

Sir:

Further to the filing of an appeal in the above referenced application, applicants request a pre-appeal brief process for the following reasons:

- 1) Claim 136, the only independent claim in the application, reads:
A method of a user interacting with an Internet site, comprising:
 - (a) transmitting to the site, by a user, a request for an Internet page;
 - (b) providing to the site, a user profile record of the user transmitting the request, by an entity not associated with the site;
 - (c) providing, responsive to the request, information content of the Internet page; and
 - (d) responding to the request, with a page presentation of the provided information content in a display format selected responsive to the user profile record.

Claim 136 was rejected under 35 USC 102(e) as being anticipated by Gerace (US patent 5,848,396). The Examiner stated that Gerace describes "transmitting to the site, by a user, a request for an internet page; and providing to the site, a user profile (creating a user profile) record of the user transmitting the request, by an entity not associated with the site."

Applicants contend that the Examiner erred in stating that in Gerace the user profile is provided to the site by an entity not associated with the site and therefore has not established a *prima facie* rejection of claim 136.

Applicants respectfully submit that in Gerace, program 31 generates and displays current agate information (Col. 4, lines 9-10) and also creates a user profile (Col. 4, lines 22-23). Thus, in Gerace, the user profile is managed by the site (which generates agate information) and not by an entity not associated with the site, as required by claim 136. Applicants did not find any suggestion in Gerace that the user profile could be provided to the site from an entity not associated with the site.

- 2) Claim 117 requires modifying a display format of a browser of the client.

Claim 117 was rejected based on fig. 4A, col. 14, lines 7-65 and col. 16, lines 5-60 of Gerace.

Applicants respectfully submit that the portions of Gerace referred to by the Examiner, relate to modifying a display format of data provided by the remote server to the client and displayed by the browser and not the browser itself. For example, col. 13, lines 47-49, of Gerace, relates to an HTML document, which is clearly the data and not the browser itself. An example of modifying a display format of the browser appears in the present application on page 3, lines 31-34.

- 3) Claim 138 requires that "said tracking comprises tracking at a computer from which the user accesses the Internet."

The Examiner rejected this claim based on Figs. 1 and 2, col. 19, lines 7-65 and col. 21, lines 5-60 of Gerace, stating that these passages relate to "tracking users' information using different computers".

Applicants submit, however, that in Gerace the tracking is performed by a "user profiling member 73", which is on web server 27 (Fig. 1) or is on an opposite side of web server 27 from the user (Fig. 2). Applicants respectfully submit that web server 27 is not a computer from which the user accesses the Internet. Nowhere could applicants find in Gerace a suggestion that the tracking be performed by a computer from which the user accesses the Internet, as required by claim 138.

- 4) Claim 158 requires responding by a plurality of separate sites with a display format adapted using a single user profile. The Examiner related to Fig. 4b, col. 17, line 18 – col. 18, line 50 and col. 19, lines 7-65 of Gerace.

Applicants respectfully submit that this limitation was not found anywhere in Gerace, which relates to using a user profile for a single site.

5) Claim 164 requires that the tracking is performed at a tracking computer which tracks access to a plurality of different unrelated web sites. Gerace, in contrast, tracks access to a single site, which is the site that is modified.

Conclusion

The above arguments were all presented to the Examiner in a response to a previous office action and were *ignored* by the Examiner in the present office action, issued December 30, 2005. The only argument to which the Examiner related was to an argument that applicants did not present at all. In fact, the argument to which the Examiner related refers to an amendment of claim 136 which applicants specifically stated broadens the claim, and was not presented in any way as overcoming the art of record.

Regarding the dependent claims, the Examiner stated that they are rejected "at least by virtue of their dependency" and by other reasons set forth in the previous office action. The Examiner did not relate to applicant's arguments regarding claim 117, but merely repeated the rejection. Neither did the Examiner relate to applicant's arguments regarding claims 138, 158 and 164.

A petition of the finality due to the ignoring of applicant's arguments was filed on February 2006, but a written response was not received for the petition yet. A telephone enquiry as to the petition resulted in a response that the petition was rejected, but applicants have not received the reasons for turning down the petition.

Applicants respectfully request allowance of the claims 76-78, 114-117 and 136-154 as the art of record does not show the elements of claim 136. The dependent claims are allowable at least by virtue of their dependence.

Respectfully submitted,

A. REFUAH et al.

Yaakov Schatz

Yaakov Schatz

Reg. No. 44,320

April 30, 2006

William H. Dippert, Esq.

Wolf, Block, Schorr & Solis-Cohen LLP

250 Park Avenue

New York, NY 10177

Tel: (212) 986-1116